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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/914,142

Michael Edmund Tobar

19724-087993

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03/21/2003

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EXAMINER

JONES, STEPHEN E

ART UNIT

PAPER NUMBER

2817

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/914,142

Applicant(s)

TOBAR, MICHAEL EDMUND

Examiner

Stephen E. Jones

Art Unit

2817

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9-13 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8 is/are rejected.
- 7) ☒ Claim(s) 4,7 and 14-18 is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the lack of unity requirement in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the invention is defined in claim 1 and is generic. Also, applicant argues that PCT Rule 13.2 relates to the ability of having various independent claims. These arguments are not found persuasive because eventhough the various species may have common features between particular species, each species also includes a special technical feature which is different from the rest, as described in the lack of unity requirement. Furthermore, PCT Rule 13.2 states that the determination of unity of invention is made without regard to whether the inventions are claimed in separate claims or as alternatives.

The requirement is still deemed proper and is therefore made FINAL.

Applicant indicated that Claims 1-4, 7, 8, and 14-18 read on the elected species.

2. Accordingly, Claims 5-6, 9-13, and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction/(lack of unity) (election) requirement in Paper No. 8.

Claim Objections

3. Claims 14-18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 14-18 have not been further

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treated on the merits. Also, note that non-elected claims 10-13 and 19 are also in an improper multiple dependent form.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "each intermediate piece being formed from either the first dielectric material or the second dielectric material" is confusing since Claim 7 requires that the intermediate pieces be formed of "the second dielectric material" (see Claim 7, lines 2-3 of page 16). The last two paragraphs of Claim 8 include similar references to the intermediate pieces being formed of the first dielectric material which thus further render the claim indefinite.

Also, lines 23-25 (page 16) and lines 1-2 (page 17) of Claim 8 are redundant recitations of what has already been claimed in Claim 7 (lines 1-6 and 10-13) of page 16. This redundancy renders the claim vague and indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gannon et al.

Gannon et al. (Fig. 1) teaches a filter including: a copper cavity (124); a plurality of dielectric materials stacked on each other forming a contiguous body; the outer dielectric materials (114, 120) are made of alumina which is known to have a much smaller dielectric constant than the inner dielectric material (116) which has a dielectric constant of 20 or more (see Col. 2, lines 40-45 and 66) (Claim 1); and the polarity of the thermal coefficient of the dielectric constant is alternating between the outside materials and the inside material (see Col. 2, lines 56-64) (Claim 2).

8. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hattori et al.

Hattori et al. (Fig. 2) teaches a resonator including: a metal cavity case (12); a plurality of dielectric materials stacked on each other forming a contiguous body; and the outer dielectric materials (10d) have a larger dielectric constant than the inner dielectric material (10e) (i.e. the inner dielectric has a relatively low dielectric constant) (see Col. 2, lines 56-60) (Claim 1, and Claim 3 as it depends on Claim 1).

Allowable Subject Matter

9. Claims 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. The following is a statement of reasons for the indication of allowable subject matter: Gannon et al. does not teach that the central piece has a length substantially an integer multiple of one-half wavelength of a desired operating frequency in the dielectric material.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ishizaki et al. teaches a dielectric heat radiator.

Sarkka teaches a dielectric resonator with a disc stacked on the resonator.

Wakino et al. teaches a stacked dielectric resonator device.

Tanaka teaches a stacked plate dielectric resonator.

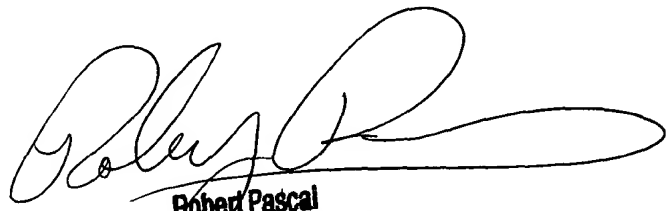
Malmstrom et al. teaches a tunable dielectric resonator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen E. Jones whose telephone number is 703-305-0390. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on 703-308-4909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6251 for regular communications and 703-308-6251 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

SEJ
March 13, 2003



Robert Pascal
Supervisory Patent Examiner
Technology Center 2800